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| 513 | 7590 | 01/25/2006 | EXAMINER | |
| WENDEROTH, LIND & PONACK, L.L.P. | | | CHAN, WING F | |
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| SUITE 800 | | | PAPER NUMBER | |
| WASHINGTON, DC 20006-1021 | | | 2643 | |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,855

Applicant(s)

NAKAMURA, TSUYOSHI

Examiner

Wing F. Chan

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 7, 17, 31, 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-3, 7, 17, 31 only recited a single element, which is a single element recitation that does not appear in combination with another recited element is subject to an undue breadth rejection under 35 U.S.C. 112 first paragraph, and thus encompasses all possible conceivable means for performing a stated function. It is a claim which depends on a recited property, a factual situation comparable to Hyatt; where the claim covers every conceivable means for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Therefore, the specification is non-enabling for failing to disclose all possible means for performing the stated function. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

Claim 32 is a single step claim, e.g. the claim recited "transmitting multimedia information...", which is a single step recitation that does not appear in combination with another recited step is subject to an undue breadth rejection under 35 U.S.C. 112

Art Unit: 2643

first paragraph, and thus encompasses all possible conceivable means for performing a stated function. It is a claim which depends on a recited property, a factual situation comparable to Hyatt; where the claim covers every conceivable step for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Therefore, the specification is non-enabling for failing to disclose all possible steps for performing the stated function. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

3. Claims 3, 4, 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide adequate written description for the invention as is claimed in claim 3. Throughout the specification it is disclose that the source transmitting telephone device transmits multimedia information to a destination telephone device prior to the destination telephone device going off-hook, but the specification fails to disclose transmitting to the source telephone device as is claimed. Thus the specification is inadequately written to provide support for claim 3.

Dependent claims 4, 13 are also rejected for the same reason since they are dependent on a rejected base claim and contain the same problem(s).

4. In the interest of applying art and compact prosecution, claim 3 will be treated as transmitting to the destination telephone device prior to the destination telephone device goes off-hook to be consistent with the specification.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-11, 13-18, 23-25, 27, 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishii et al (JP 62-188539 hereinafter Ishii).

As to claims 1-3, 7, 17, 18, 23, 24, 27, 32, Ishii discloses a telephone and a communication method as claimed. Ishii teaches sending to destination telephone device multimedia information (caller information including text or image, ring tone specific to the caller in the same manner as applicant) prior to the destination telephone device going off-hook. For example, see abstract and the translation.

As to claim 4, note that Ishii teaches sending an image of the caller and this image of the caller is "image expressing" as claimed.

As to claims 5, 6, 8, the claimed base station reads on exchange 30 as disclosed by Ishii.

As to claims 13-16, 25, note that Ishii teaches sending an image of the caller and this image of the caller is "a face image" as claimed; e.g. see translation page 4 last paragraph.

As to claims 9-11, the receiving telephone device disclosed by Ishii comprises a communication interface 13 (image generating unit for receiving image transmitted from the source) caller display device 4d, and the claimed base station reads on exchange 30 as disclosed by Ishii.

7. Claims 1-11, 13-18, 23-25, 27, 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukuda (US PAT. NO. 6,810,115 filed July 3, 2002).

As to claims 1-3, 7, 9-11, 17, 18, 23, 24, 27, 32, Fukuda discloses a telephone and a communication method as claimed. Fukuda teaches sending to destination telephone device multiplexed multimedia information (caller information including text, image, music specific to the caller in the same manner as applicant) prior to the destination telephone device going off-hook. Fukuda also discloses receiving telephone device comprises a display 26 and an image decoder portion for receiving and displaying the image of the caller. For example see Figs. 2-3, col. 6 line 50 to col. 12 line 11.

As to claim 4, note that Fukuda teaches sending an image of the caller and this image of the caller is "image expressing" as claimed.

As to claims 5, 6, 8, the claimed base station reads on mobile network 10b which inherently includes a base station.

As to claims 13-16, 25, note that Fukuda teaches sending an image of the caller and this image of the caller is "a face image" as claimed; e.g. see translation page 4 last paragraph.

8. Claims 1-11, 13-18, 23-25, 27, 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Bierman et al (US PAT. NO. 5,761,279 hereinafter Bierman).

As to claims 1-3, 7, 9-11, 17, 18, 23, 24, 27, 32, Bierman discloses a telephone and a communication method as claimed. Bierman teaches sending to destination telephone device multiplexed multimedia information (caller information including text, image, music specific to the caller in the same manner as applicant) prior to the destination telephone device going off-hook. Bierman also discloses receiving telephone device comprises a display 43 and an image decoder portion for receiving and displaying the image of the caller. For example see Figs. 1-5, col. 2 line 63 to col. 4 line 52.

As to claim 4, note that Bierman teaches sending a face image of the caller having facial representation and this image of the caller is "image expressing" as claimed.

As to claims 5, 6, 8, 13-16, 25, the claimed base station reads on called central office, see Fig. 4.

9. Claims 1-11, 13-18, 23-25, 27, 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Paik et al (US PAT. NO. 6,675,008 filed July 13, 2000 hereinafter Paik).

As to claims 1-3, 7, 9-11, 17, 18, 23, 24, 27, 32, Paik discloses a telephone and a communication method as claimed. Paik teaches sending to destination telephone device multiplexed multimedia information (caller information including text, image, audio specific to the caller in the same manner as applicant) prior to the destination telephone device going off-hook. Paik also discloses receiving telephone device comprises a display 12 and an image decoder portion for receiving and displaying the image of the caller. For example see Figs. 1-8, col. 1 line 33 to col. 12 line 38.

As to claim 4, note that Paik teaches sending picture information representing a user characteristic (e.g. col. 2 line 22-34 of the caller and this picture of the caller is "image expressing" as claimed.

As to claims 5, 6, 8, note base station 20.

As to claims 13-16, 25, note that Paik teaches sending a picture image of the caller and this image of the caller is "a face image" as claimed; e.g. see col. 6 lines 37-46.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 12, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii.

As to claims 12, 26, Ishii does not disclose a second image generating means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ishii to comprise second image generating means, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

12. Claims 12, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda.

As to claims 12, 26, Fukuda although discloses an image input portion and a character input portion both of which can be interpreted as being imaging means and that both input is combined into one to be transmitted to a destination telephone, Fukuda does not explicitly disclose a second image generating means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fukuda to comprise second image generating means such that additional images can be combined to sent to the destination , since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

13. Claims 12, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paik.

As to claims 12, 26, Paik although discloses an image input portion 6 and a character input portion 5 both of which can be interpreted as being imaging means and that both input is combined into one to be transmitted to a destination telephone, Fukuda does not explicitly disclose a second image generating means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Paik to comprise second image generating means such that additional images can be combined to sent to the destination, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

14. Claims 19-22, 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Ishii, Fukuda or Paik in view of Wolff et al (US PAT. NO. 5,327,486 hereinafter Wolff).

Ishii, Fukuda or Paik differs from the claimed invention in not disclosing transmitting predetermined image or sound to the source telephone device after the destination telephone device is in the off-hook state to cutoff communications between the two telephone devices. However, it is old and well known in the art to transmitting predetermined image or sound to the source telephone device after the destination telephone device is in the off-hook state to cutoff communications between the two telephone devices to avoid unnecessary interruptions, for example see Wolff abstract, Figs. 2-11, col. 1 line 63 to col. 8 line 40, to give the called party options as to how to handle the incoming call. Thus, it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify anyone of Ishii, Fukuda or Paik to comprise means for transmitting predetermined image or sound to the source telephone device after the destination telephone device is in the off-hook state to cutoff communications between the two telephone devices to give the called party flexible options as to how to handle the incoming call to avoid unnecessary interruptions.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PAT. NO. 5,999,599.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wing F. Chan whose telephone number is 571-272-7493. The examiner can normally be reached on Monday to Friday from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wing F. Chan
Primary Examiner
Art Unit 2643